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Dated: September 2, 2009

Signature:  (Donna Forbit)

Docket No.: 66729/P038US/10614714
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Roy Schoenberg

Application No.: 10/727,184

Confirmation No.: 4980

Filed: December 3, 2003

Art Unit: 2156

For: RANGE DEFINITION METHOD AND
SYSTEM

Examiner: K. S. Lu

**RESPONSE TO NOTIFICATION OF
NON-COMPLIANT APPEAL BRIEF**

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Commissioner:

This Response is filed to address the informalities cited in the Notification of Non-Compliant Appeal Brief dated August 24, 2009 (the "Notice"). The Notice contends that the Summary of Claimed Subject Matter section of the Brief refers to too much of the specification; however, as discussed below, there is no restriction in the rules regarding how much of the specification the Brief may reference, and the Brief as filed is fully compliant with all pertinent rules. Accordingly, there is simply no basis for the asserted non-compliance, and therefore the Notice should be withdrawn.

Appellant files concurrent with this Response a Petition to the Director under 37 C.F.R. 1.181 requesting the Director to withdraw the Notice of Non-Compliant Appeal Brief dated August 24, 2009 (the "Notice") based on the failure of the Examiner to identify any rule or regulation with which the Appeal Brief filed June 19, 2009 (the "Brief") fails to comply. Appellant files this Response to ensure that the required response to the Notice by the one-month due date is met and the appeal is not dismissed. A corrected or amended Appeal Brief is not submitted herewith because, for the reasons discussed further below,

Appellant contends that the Notice is improper and the originally-filed Brief is compliant with the pertinent rules.

Based on box number 4 on page 1 of the Notice being checked, the Notice appears to allege that the Brief fails to comply with 37 CFR 41.37(c)(1)(v), which provides in part:

Summary of claimed subject matter. A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters....

The Brief complies with this rule, as it includes a Summary of Claimed Subject Matter section that provides a concise explanation of the subject matter defined in each independent claim which refers to the specification by page and line number as well as to the drawing by reference characters, *see* pages 4-6 of the Brief.

However, in the explanation provided on page 2 of the Notice, the Examiner contends that the Summary of Claimed Subject Matter (“Summary section”) of the Brief cites to too much of the specification. Appellant respectfully notes that while 37 CFR 41.37(c)(1)(v) instructs that a concise explanation of the subject matter defined in each independent claim be included in the Brief, it places no restriction on the amount of description in the specification to which the explanation may reference. While Appellant does not intend for the citation to passages in the specification and drawings to imply in any way that the limitations from the specification and drawings should be read into the claims, Appellant has complied with the requirements of 37 CFR 41.37(c)(1)(v) by including reference to the specification and drawings. Further, Appellant has cited not only to a single sentence in the specification that maps precisely to the language of the claim limitation (as the Examiner would apparently prefer), but has cited to additional sentences and paragraphs that Appellant believes might aid the Board in its understanding of the specification’s description.

In an effort to resolve this issue and receive further guidance from the Examiner concerning the appropriate amount of the specification to which the Appellant may refer in the Summary section of the Brief, Appellant’s representative, Jody Bishop, initiated a teleconference with the Examiner, Kuen S. Lu, on August 28, 2009. The Examiner’s only explanation concerning the issue raised by the Notice is that the policy of the current

administration of the Office is to limit the amount of the specification to which an Appellant may refer in the Summary section of a Brief. Appellant's representative requested guidance regarding how much or how little of the specification one might properly refer to in compliance with 37 CFR 41.37(c)(1)(v) (considering that this section of the CFR places no such restriction), and the Examiner could not provide any such guidance or identify any such guidance within the CFR.

In a further effort to resolve the issue, Appellant's representative discussed the example #1 identified on page 2 of the Notice with regard to independent claim 1. This example contends that the reference to "paragraphs 0035-0045 at page 10, line 8 – page 12, line 19 of the specification" in the Summary section for the recited limitation "a plurality of text-based range descriptors, wherein each text-based range descriptor is associated with a range of field values for one of the range-based data fields" is too long and/or fails to provide disclosure of the limitation for which it is referenced.

In discussing this example #1 raised in the Notice, Appellant's representative first noted that there is no restriction or guidance in 37 CFR 41.37(c)(1)(v) that would prohibit the Summary section from properly referencing the 11 paragraphs (0035-0045). Appellant's representative further noted that the referenced paragraphs clearly provide an explanation of an exemplary embodiment, including a description corresponding to the recited limitation of claim 1. Appellant's representative noted that paragraphs 0043-0045 of the specification clearly provide a specific example of use of text-based range descriptors that are each associated with a range of field values for a "cholesterol" data field. For instance, the cited paragraphs describe an example in which five text-based range descriptors ("1", "2", "3", "4", and "5") are employed to represent a total cholesterol reading of <150, 150-199, 200-239, 240-274, and >275, respectively. Paragraphs 0035-0042 are also referenced for context and to aid the reader's understanding of the specific example described in paragraphs 0043-0045. Considering that the entire specification is 65 paragraphs long, Appellant respectfully submits that referencing a mere 11 paragraphs thereof in an effort to aid the Board in focusing on a corresponding portion of the specification pertaining to a given limitation of a claim is not unreasonable.

Considering that the Summary section of the Brief as filed appears to fully comply with the requirements of 37 CFR 41.37(c)(1)(v), Appellant respectfully submits that the Notice is improper because the Brief, as filed, is fully compliant with this rule. Further, because Appellant is afforded no guidance regarding how much of the specification the Appellant may refer to in satisfaction of 37 CFR 41.37(c)(1)(v), Appellant respectfully submits that there is no clear way of how to amend the Brief as filed in an effort to overcome the improper Notice.

Therefore, the Notice of Non-Compliant Appeal Brief dated August 24, 2009 should be withdrawn for the above reasons.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 50-3948, under Order No. 66729/P038US/10614714 from which the undersigned is authorized to draw. Please charge any additional fees required or credit any overpayment to Deposit Account 50-3948 during the pendency of this Application pursuant to 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees.

Dated: September 2, 2009

Respectfully submitted,

By 

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